



Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

Group Art Unit: 1714

Serial No.: 09/398,377

Examiner: Szekely, P.

Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Mail Stop AF

Commissioner for Patents

Attention Petitions Branch

P.O. Box 1450

Alexandria, VA 22313-1450

12/15/2003 DTESSEH1 00000009 09398377

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130.00 OP

PETITION

Sir,

This is a petition to the Commissioner

(1) to direct the Examiner to withdraw the finality of the Office Action mailed October 10, 2003, on the ground that a clear issue for appeal has not been developed, and

(2) insofar as the Commissioner deems it appropriate, to direct the Examiner to provide reasoned answers to the Applicants' arguments.

Background

On June 17, 2003, Applicants mailed a Petition to direct the Examiner as to the Correct Construction of the Claims. On October 7, 2003, the Commissioner dismissed

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop AF Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
On December 10, 2003

Typed name of person signing this certificate: T. H. P. Richardson
Signature

the Petition because there was no issue ripe for petition, there being at that time no final rejection, and because, although it was desirable that any appeal should be based on an agreed construction of the claims, that issue did not appear to be a petitionable matter. The decision also stated

Before making the next office action final, the Examiner should clearly point out how he is interpreting the claims and provide clear reasoning as to why he is interpreting the claims in that manner. Applicant's arguments regarding this matter should be thoroughly addressed.

Upon receipt of a final office action, if Petitioner feels that a clear issue for appeal has not been developed, then a petition to withdraw the finality can be filed.

Copies of the previously-filed Petition and the Commissioner's Decision are attached. Also attached is a copy of the Reply mailed June 17, 2003, to which reference will be made below.

The Examiner has now made a final rejection. Applicants believe that the finality of the rejection should be withdrawn, because a clear issue for appeal has not been developed. The issues that remain unclear are set out below.

1. The Construction of the Claims

For the reasons explained below, the correct construction of the claims is fundamental to clarification of the rejections under 35 USC 102 and 103. Under these circumstances, the Commissioner is asked to reconsider the earlier decision stating that the construction of the claims "does not appear to be a petitionable matter".

In the final Office Action, the Examiner makes the following statement with regard to the construction of claims.

Morawsky et al.... does contain the phrase "present in the amount sufficient to thicken the composition"... so that limitation is not new matter... Since Morawsky et al. define that amount as 0.1-12% by weight based on the oil, the phrase will be interpreted as such. Applicants do not agree with the Examiner about

Morawsky et al. limiting the useful concentration range of the thickener to the above range. It is their privilege. However this disagreement is completely inconsequential as far as the instant rejection is concerned.

Thus, the Examiner has not "thoroughly addressed" the reasons set out in the previously filed Petition, in particular in paragraphs A-D on pages 7-8 thereof, in support of Applicants' argument that the Examiner's construction of the claims is wrong. Rather, the Examiner has simply asserted that the disagreement as to the construction of the claims "is completely inconsequential so far as the instant rejection is concerned".

The Final Office Action then continues: --

Morawsky et al. prove that the 0.1-12% by weight based on the oil concentration range is synonymous to or within the claimed concentration range which thickens the oil. Therefore, said concentration range overlaps the 0.001-1% by weight based on the oil concentration range disclosed by Mueller et al 5,281,329, and thus applicants' claims are not novel or non-obvious over the disclosures of the cited references.

Applicants are not entirely confident that they have completely understood this passage. However, it appears that the Examiner is saying that because there is an overlap between

- (i) the broadest numerical range explicitly disclosed in Morawsky et al. (0.1-12%) for the amount of certain specifically defined carboxyl-containing side chain crystalline (SCC) polymer to be used to thicken oils, and
- (ii) the broadest numerical range explicitly disclosed in Mueller et al. (0.001-1%) for the amount of certain specifically defined SCC polymers (which do not contain the carboxyl groups essential to Morawsky et al.) to be used in order to depress the pour point of certain oils (which necessarily means that the effect of the SCC polymer is to make the oil thinner, not to make the oil thicker),

it necessarily follows that the rejected claims are not novel.

Thus, it appears that the Examiner is not only saying that the rejected claims are limited to amounts of the additive in the range 0.1-12%, but is also saying that the

stated requirement that the additive thickens the oil should be ignored. This is the only possible explanation for the Examiner's rejection of the claims under 35 USC 102 over Mueller et al, in which the additive is used in an amount which makes the oil thinner, not thicker. [At one time during prosecution, the Examiner appeared to think that use of an additive as a pour point depressant for an oil was synonymous with thickening the oil. In fact, the reverse is true; there can be no doubt that Mueller's additive, when used in accordance with Mueller's instructions, functions as a thinner in the temperature range between (i) the pour point of the oil and (ii) the pour point of the mixture of oil and additive--nor is there any reason to suppose that the same is not true at higher temperatures.]

Applicants believe, therefore, that the correct construction of claims, so far from being "completely inconsequential", is fundamental to the rejections, which must be withdrawn if the claims are correctly construed. Even if the Commissioner continues to think that the proper construction of claims is not a matter that can be dealt with by way of petition, Applicants suggest that the Commissioner should direct the Examiner to formulate his rejections in alternative forms, one form directed to the construction that the Examiner believes to be correct and the other form directed to the construction that Applicants believe to be correct. There will otherwise be a danger that, if the Examiner's construction is found to be wrong (no doubt after a lengthy appeal process), prosecution will have to resume, based on a new construction of claims.

2. The rejection of the claims under 35 USC 102

(a) A number of the claims have been rejected under 35 USC 102 "as being anticipated by Mueller et al 5,281,329, with Morawsky et al. 5,736 125 as a teaching reference". The claims were likewise rejected in the previous Office Action on this ground, and as out in detail on page 23, line 6-10, of the attached Reply, Applicants argued that such a rejection was improper because a rejection under 35 USC 102 must be based on a single reference. The Examiner has made no comment on the argument.

(b) As set out in detail on page 23, line 13, to page 26, line 10, Applicants argued that the rejection under 35 USC 102 should be withdrawn because (1) the claims require that the SCC polymer is present in an amount such that it thickens the oil, and (2) the claims are directed to cosmetic compositions. As noted above, it appears that the Examiner, because he has adopted an incorrect construction of the claims, thinks that the first of these differences is unimportant; in any event he has made no comment on Applicants' arguments beyond that set out above. As to the fact that the claims are directed to cosmetic compositions, the Final Office Action states: –

The Examiner iterates and reiterates his previous statements that Mueller et al encompasses such cosmetic compositions as mineral oil and vaseline...

The Examiner has made no comment on the arguments set out on page 24, lines 9-21 and page 25, line 17-page 26, line 10, of the previous Reply, for example the fact that Mueller does not disclose mineral oil or vaseline or any composition that is stated to be, or is inherently, a cosmetic composition.

3. The rejection of the claims under 35 USC 103

(a) A number of the claims have been rejected under 35 USC 103 over Mueller et al 5,281,329 in view of Morawsky et al. 5,736,125. The claims were likewise rejected in the previous Office Action on this ground, and as out in detail on page 26, line 26-page 27, line 13, of the attached Reply, Applicants argued that such a rejection was improper because there was no reason to read these references together. The Final Rejection contains no comment on this argument.

(b) Applicants also argued, on page 27, line 15-page 30, line 7, of the attached Reply, that even if the references could properly be combined, they did not disclose or suggest the claimed invention. For example, Applicants noted that

(i) the SCC polymers used by Mueller and Morawsky are different, and there is nothing to suggest that the SCC polymers used by Mueller are interchangeable with the SCC polymers used by Morawsky;

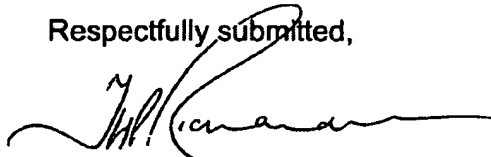
(ii) Mueller's objective is to lower the pour point of an oil, which necessarily means that the oil is made thinner, whereas Morawsky's objective is to thicken an oil;

(iii) Mueller discloses a preferred range of 0.005 to 0.2% for the concentration of additive, and in fact uses, in the specific Examples, 0.04 to 0.1%; and Morawsky discloses a preferred range of 0.5 to 10%, and in fact uses, in the specific Examples 5%., so that there is no overlap between the concentration ranges in which Mueller and Morawsky achieved practical results.

4. The rejection of claim 6 under 35 USC 103

On page 22, lines 26-31 of the attached Reply, it was noted that claims 6 and 7 had been rejected under 35 USC 102 and that claim 6 (but not claim 7) had been rejected under 35 USC 103; that those claims require the presence of hydroxyl groups in the SCC polymer additive; that there is nothing in Mueller to suggest the use of hydroxyl-containing SCC polymers; and that the office action says nothing about this difference. In the outstanding Final Rejection, claims 6 and 7 are no longer rejected under 35 USC 102, but claim 6 remains rejected under 35 USC 103, without any reasons given for the rejection.

Respectfully submitted,



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

Group Art Unit: 1714

Serial No.: 09/398,377

Examiner: Szekely, P.

Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Assistant Commissioner for Patents

Attention Petitions Branch

Washington, DC 20231

PETITION

Sir,

This Petition is being filed contemporaneously with a very similar petition on the closely related CIP application Serial No. 09/810, 920. It is believed that the Commissioner will find it convenient to consider both petitions at the same time.

This is a petition asking the Commissioner to direct the Examiner as to the correct construction of certain claims. The Examiner is currently examining these claims on the basis of a construction of the claims which Applicant believes to be wrong. The claims in question have been rejected, and it seems likely that their patentability will be the subject of an appeal. Applicant believes that it is important that further examination, and any appeal, should be based on an agreed construction of the claims.

The Claims

Originally mailed June 17, 2003. This Copy filed with Petition mailed December 10, 2003

The invention relates to the use of certain side chain crystalline (SCC) polymers as thickening agents for oil-containing compositions. The claims in question are independent claims 40 and 45, which are set out below (with emphasis added). These claims are directed to compositions containing an oil and the thickening agent "in amount such that it thickens the oil". The Examiner is examining these claims on the basis that this phrase means (and that the claims are therefore limited to) compositions containing 0.1 to 12% by weight of the SCC polymer.

The application includes claims which are dependent on independent claims 40 and 45 and which have also been rejected. The application also includes other independent claims, and claims dependent thereon, which have been allowed and as to which there is no dispute.

40. *A thickened oil cosmetic composition which comprises*
- (1) an oil, and*
 - (2) dispersed in the oil, a polymer which*
 - (a) has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;*
 - (b) is soluble in the oil at temperatures above T_p ,*
 - (c) has been dispersed in the oil by a process which comprises*
 - (i) dissolving the polymer in the oil at a temperature above T_p , and*
 - (ii) cooling the solution to crystallize the polymer in the oil,*
 - (d) is a side chain crystalline (SCC) homopolymer which is substantially free of functional groups, and*
 - (e) is present in amount such that it thickens the oil;*
- the composition being at a temperature*
- (i) which is below T_p , and*
 - (ii) at which the composition, in the absence of the polymer, is liquid.*

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45. *A thickened oil cosmetic composition comprising*
- (1) *an oil, and*
 - (2) *dispersed in the oil, a polymer which*
 - (a) *has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;*
 - (b) *is soluble in the oil at temperatures above T_p ,*
 - (c) *has been dispersed in the oil by a process which comprises*
 - (i) *dissolving the polymer in the oil at a temperature above T_p , and*
 - (ii) *cooling the solution to crystallize the polymer in the oil,*
 - (d) *is a side chain crystalline (SCC) polymer which is substantially free of functional groups, and which consists of*
 - (i) *50 to 100% by weight of units derived from at least one n-alkyl acrylate or methacrylate in which the n-alkyl group contains 12 to 50 carbon atoms, and*
 - (ii) *0 to 50% by weight of units derived from at least one alkyl acrylate or methacrylate in which the alkyl group is not an n-alkyl group containing 12 to 50 carbon atoms, and*
 - (e) *is present in amount such that it thickens the oil;*
- the composition being at a temperature*
- (i) *which is below T_p , and*
 - (ii) *at which the composition, in the absence of the polymer, is liquid.*

The Issue

Originally mailed June 17, 2003. This Copy filed with Petition mailed December 10, 2003

The issue is the meaning of the phrase "is present in amount such that it thickens the oil".

The Relevant Facts

1. The Disclosure of the Specification as filed.

The specification as filed does not state explicitly that the thickening agent "is present in amount such that it thickens the oil". It does, however, contain numerous statements and specific Examples which make it clear that the purpose and result of adding the crystalline polymer thickening agent is to thicken the oil. The following passages are quoted by way of example.

Polymeric Thickeners for Oil-Containing Compositions (title)

It is known to use polymers to thicken oil-containing compositions.

Reference may be made for example to U.S. Patent No. 5, 318,995 (Mondet et al.) and U.S. Patent No. 5, 736,125 (Morawsky et al.) the disclosure of each of which is incorporated herein by reference for all purposes. (Page 1, lines 10-13)

I have discovered, in accordance with the present invention, that oil-containing compositions can be thickened with polymers which contain long chain alkyl groups in side chains but which contain no, or relatively few, acid groups as specified in U.S. Patent No. 5,736,125 or acid salt groups as specified in U.S. Patent No. 5,318 995. Furthermore I have been able to obtain improved results through the use of such polymers. The polymers which are useful in the present invention are crystalline polymers, preferably side chain crystalline (SCC) polymers which...

the use of such polymers as thickening agents (page 3, lines 18-19),

the polymers used as thickeners in the present invention (page 5, line 15),

the thickening polymer (page 8, lines 23 and 30),

the polymeric thickener (page 5, line 13, page 9, lines 12, 18 and 25),

The amount of the polymeric thickener preferably used varies with the

application. It is usually unnecessary to use more than 10% of the total

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composition, and smaller amounts such as 3 to 7%, for example about 5%, are often effective. (Page 9, lines 12-14)
a thickened oil composition (Claim 1, line 1).

2. After the claims had been rejected under 35 U.S.C. 102 and 103 over U.S. Patent No. 5,281,329 ("Mueller"), Applicant limited the claims to require that the thickening agent "is present in amount such that it thickens the oil", and argued that this limitation distinguished the claims from the Mueller reference.

3. The Examiner rejected the amended claims under 35 U.S.C. 112 for lack of written description on the ground that the added limitation involved new subject matter, and for lack of enablement.

4. In the Reply mailed July 31, 2002, and the Supplemental Reply mailed Oct. 17, 2002, Applicant traversed the rejection under 35 U.S.C. 112, arguing that no new subject matter was involved and that the claims were enabled, referring to the passages in the specification quoted above, and noting that the specification provides specific examples of thickened oils.

5. The Office Action mailed November 25, 2002, withdrew the rejection under 35 U.S.C. 112, and stated:

The Examiner acknowledges that Morawsky... incorporated by reference, does contain the phrase "present in the amount sufficient to thicken the composition" in column 3, lines 19-24, so that limitation is not new matter. Since (Morawsky) defines that amount as 0.1-12% by weight, the phrase will be interpreted as such.

6. The disclosure of Morawsky.

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Morawsky, which is also summarized on page 1, lines 15-24, of the specification as filed, discloses that certain specifically defined carboxyl-containing SCC polymers can be used to thicken oils. The following passages are quoted from Morawsky.

In the compositions, the amount of thickening copolymer, as defined above, is present in an amount sufficient to thicken the composition to the desired thickness. In general it is present in an amount of from about 0.1% to about 12%, particularly from about 0.5 to about 10% by weight of the oil.... The composition may be thickened to the desired viscosity which is dependent on the functional properties of composition. (Column 3, lines 19-33).

1. *A composition comprising an oil and a polymeric thickener consisting essentially of at least one copolymer which has a hydrophobic functionality sufficient to provide at least partial solubility in oil and a hydrophobic functionality present in an amount effective to provide thickening of the oil, said hydrophobic functionality being... (Claim 1).*

6. *The composition of Claim 1, wherein the copolymer is present in an amount ranging from about 0.1 to about 12% by weight of the oil. (Claim 6).*

7. In the Reply mailed January 27, 2003, Applicant argued, referring to the passages quoted in paragraph 6 above, that neither the claims nor Morawsky should be interpreted to have the limited meaning adopted by the Examiner; and asked the Examiner to state on the record that further examination would be carried out on the basis that the phrase mean simply what it says and is not limited to amounts in the range 0.1 to 12 %.

8. The Office Action mailed March 31, 2003, does not state whether the continued rejection of the claims was based on the Examiner's limited construction.

9. In a telephone interview with the undersigned on June 12, 2003, the Examiner made statements which, insofar as they could be understood by the undersigned,

Originally mailed June 17, 2003. This Copy filed with Petition mailed December 10, 2003

indicated that the Examiner was continuing examination on the basis of the limited construction of the claims.

10. In the Reply mailed contemporaneously with this Petition, Applicant asked the Examiner once again to consider the proper construction of the claims, and either

- (i) to state on the record his agreement that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%, or
- (ii) to send this Petition to the Petitions Branch so that the issue could be resolved.

11. The Reply mailed contemporaneously with this Petition also requests amendments which result in the following claims 42 and 50 which are dependent on claims 40 and 45 respectively, and which specify that the thickening agent is present in amount 0.1 to 12% by weight.

42. A composition according to Claim 40 wherein the SCC polymer is present in amount 0.1 to 12% by weight.

50. A composition according to Claim 45 wherein the SCC polymer is present in amount 0.1 to 12% by weight.

The specification as filed does not state explicitly that the thickening agent can be present in amount 0.1 to 12%. The basis for these claims is in above-quoted passages of Morawsky U.S. Patent No. 5,736,125, which is incorporated by reference. Applicant's purpose in adding these claims is to provide further evidence, through the doctrine of claim differentiation, that claims 40 and 45 cover amounts of the SCC polymer outside the range of 0.1 to 12%.

Argument

Originally mailed June 17, 2003. This Copy filed with Petition mailed December 10, 2003

For the reasons set out below, Applicant believes that the claims 40 and 45 should not be examined on the basis of the limited construction adopted by the Examiner, but rather on the basis that the claims cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%.

A. The passages quoted in paragraph 1 above from the specification as filed make it clear that Applicant's invention is directed broadly to the use of the defined SCC polymers as thickening agents for oil-containing compositions, and is not limited to any specific numerical range of concentration. The disclosure of the specification itself is reinforced by the facts and arguments set out in

(i) the Reply mailed July 31, 2002, and the Supplemental Reply mailed Oct. 17, 2002, and

(ii) the Reply mailed January 27, 2002, on the CIP application Serial No. 09/810,190,

to which reference should be made.

B. The passages quoted in paragraph 6 above from Morawsky make it clear that Morawsky's invention is directed broadly to the use of the defined carboxyl-containing SCC polymers as thickening agents for oil-containing compositions, and is not limited to the use of 0.1 to 12% of the SCC polymer. The quoted passage from column 3, lines 19-33, states simply that the SCC polymer is used "in an amount sufficient to thicken the composition, and then goes on to state that "in general" (i.e. not invariably) the amount is from "about 0.1% to about 12%". Claim 1 similarly refers to "an amount effective to provide thickening of the oil", and the presence of Claim 6, specifying that the amount is 0.1 to 12% and not otherwise limiting Claim 1, puts it beyond doubt (having regard to the requirement of 35 U.S.C. 112, fourth paragraph, that a dependent claim must "specify a further limitation of the subject matter claimed) that the amount referred to in Claim 1 is not limited to the range of 0.1 to 12%.

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C. The presence of amended claims 42 and 50 makes it clear (again having regard to 35 U.S.C. 112, fourth paragraph) that claims 40 and 45 are not limited to the range of 0.1 to 12%.

D. MPEP 2111 requires that during Patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification".

Respectfully submitted,

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**Originally mailed June 17, 2003. This Copy filed with Petition
mailed December 10, 2003**



UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of

Bitler et al.

Serial No. 09/810,920

Filed: March 16, 2001

For: POLYMERIC THICKENERS FOR OIL-CONTAINING COMPOSITIONS

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO DIRECT THE EXAMINER AS TO THE CORRECT CONSTRUCTION OF CERTAIN CLAIMS.

On March 31, 2003, a non-final office action was mailed to Applicants. The office action contained numerous rejections and objections to the specification based on new matter and claim interpretation. Petitioner argues that the instant specification provides support for all of the subject matter presented by Applicants and that the examiner is interpreting the instant claims too narrowly.

On June 23, 2003 the instant petition under 37 CFR 1.181 was filed to formally request that the examiner be directed to construct the instant claims in a correct manner.

DECISION

It is noted that the instant petition was submitted by Petitioner on June 23, 2003 which falls more than two months after the date of the office action thereby making the instant petition untimely under Rule 181.

In addition, it would appear on its face that there is no issue that is ripe for a petition at this time. It is noted that the outstanding office action is a non-final office action and therefore, the rejections and objections are not yet final. Petitioner states that "The examiner is currently examining these claims on the basis of a construction of the claims which Applicant believes to be wrong. The claims in question have been rejected, and it seems likely that their patentability will be the subject of an appeal. Applicant believes that it is important that further examination, and any appeal, should be based on an agreed construction of the claims." While this would be desirable, this does not appear to be a petitionable matter. It would seem that the issue of claim interpretation and the subsequent rejections/objections presented that are based upon this interpretation, should best be handled by the Board of Patent Appeals and Interferences.

COPY filed with Petition mailed 12/10/03

Accordingly, because the instant petition is untimely and because there does not appear to be a petitionable issue present, the instant petition is **DISMISSED**.

The examiner however, should take note of Section MPEP Section 706.07 of the MPEP which states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

Before making the next office action final, the examiner should clearly point out how he is interpreting the claims and provide clear reasoning as to why he is interpreting the claims in that manner. Applicant's arguments regarding this matter should be thoroughly addressed.

Upon receipt of a final office action, if Petitioner feels that a clear issue for appeal has not been developed, then a petition to withdraw the finality can be filed.

It is also pointed out that applicant's time for response continues to run from March 31, 2003. Extensions of time may be obtained to file any amendments.



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